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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/712,872	11/15/2000	Ralph W. Wright JR.	A148 1596	9345

7590

06/16/2004

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EXAMINER

FERGUSON, LAWRENCE D

ART UNIT	PAPER NUMBER
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1774

DATE MAILED: 06/16/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/712,872

Applicant(s)

WRIGHT ET AL.

Examiner

Lawrence D Ferguson

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
 - If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
 - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
 - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 31 March 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-3, 5-14, 16-28 and 56-65 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 56-59, 63 and 65 is/are allowed.
- 6) ☒ Claim(s) 1-3, 5-14, 16-28, 60-62 and 64 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 3/31/04.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Response to Amendment

1. This action is in response to the amendment mailed March 31, 2004. Claims 9-10, 20-21, 62 and 64 were amended rendering claims 1-3, 5-14, 16-28 and 56-65 pending.

New Matter - 35 U.S.C. 112

2. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3. Claims 9-10, 20-21, 62 and 64 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The phrase "...and least some portion of the indentations is free of the pigmented wear layer" is not supported by the specification or Figures 8 and 9 as stated by Applicants.

Claim Rejections – 35 USC § 103(a)

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the

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invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 1-3, 5-10, 12-14, 16-21, 23-28, 60-62 and 64 are rejected under 35 U.S.C. 103(a) as being unpatentable over Shalov et al. (U.S. 5,830,937) in view of Ehrhart et al (U.S. 5,543,232).

Shalov discloses a surface covering comprising a chemically or mechanically embossed substrate (column 19, lines 1-7), a UV light radiation cured pigmented intermediate wear layer and a UV light radiation cured topcoat which has high gloss values and excellent resistance to stains (Abstract and column 22, lines 31-34) where UV light curable pigment comprises ultraviolet light curable resin. Shalov discloses the topcoat and wear layer comprise polyester acrylates (column 10, lines 37-67). Shalov discloses that the surface covering further comprises a printed pattern in which the pigmented topcoat is in register with by indenting with the printed pattern (Figure 2). The reference discloses that the topcoat and intermediate wear layer are in register with the embossed texture of the substrate by indenting with the substrate (Figure 2) where the embossed substrate has raised surfaces and indentions and that the pigmented topcoat and intermediate wear layer are disposed on the raised surfaces and in the indentions.

Shalov does not disclose that the stain resistance is about less than 150 Delta E units (as in instant claim 1) or that the topcoat has a gloss retention of at least about 80% (as in instant claim 13). Ehrhart shows a floor covering comprising a substrate and a UV radiation cured acrylated polyester wear layer having a stain resistance of 2682 Delta E units and a gloss retention of 87%-93% (abstract and column 9, line 29 to column 10, line 6) where the substrate comprises a laminated film (column 9, lines 18-

19). It would have been obvious to one of ordinary skill in the art to make the surface covering of Shalov with the stain resistance of less than about 150 Delta E units since it is known, as shown by Ehrhart, that radiation curable topcoat layers with such a strain resistance is desirable in floor coverings to prevent household stains from becoming permanent in the floor covering.

Claim Rejections – 35 USC § 103(a)

6. Claims 11 and 22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Shalov et al. (U.S. 5,830,937) in view of Ehrhart et al (U.S. 5,543,232) further in view of Sawka et al. (U.S. 5,405,675)..

Shalov and Ehrhart are relied upon as above for claims 1 and 12. Shalov does not disclose the nacreous pigments as in instant claims 11 and 22. Sawka teaches that pearlescent dyes (nacreous pigment) can be used in color layers of an embossed multilayered film (column 8, lines 5-14). It would have been obvious to one of ordinary skill in the art to use nacreous pigments in the pigmented topcoat of Shalov since it is known, as shown by Sawka, that various pigments such as nacreous pigments can be used to achieve a pearlescent color in the surface covering.

7. Claims 56-59, 63 and 65 are allowed.

Response to Arguments

8. Rejection made under 35 U.S.C. 101 as claiming the same invention as that of claims 1-28 of copending Application No. 10/395297 is withdrawn due to claims 1-28 of Application No. 10.395297 being cancelled.

Remarks towards rejections made under 35 USC 103(a) as being unpatentable over Shalov et al. (U.S. 5,830,937) in view of Ehrhart et al (U.S. 5,543,232) and over Shalov et al. (U.S. 5,830,937) in view of Ehrhart et al (U.S. 5,543,232) further in view of Sawka et al. (U.S. 5,405,675) have been considered but are unpersuasive. Applicant argues while Shalov discloses a topcoat and wear layer that comprise polyester acrylates, the present claims are limited to topcoats and wear layers in which the resin binder consists essentially of a thermoset resin that may include an acrylated polyester. Although Applicant uses the claim language, "the resin binder consists essentially of a thermoset resin selected from the group consisting of an ultraviolet light curable resin, electron beam curable resin and a combination thereof, the decorative floor covering may contain additional materials other than ultraviolet light curable resin and electron beam curable resin because in instant claim 1, Applicant uses the claim language "a decorative floor covering comprising" which is an open ended transitional phrase. The transitional term "comprising", which is synonymous with "including," "containing," or "characterized by," is inclusive or open-ended and does not exclude additional, unrecited elements or method steps. See, e.g., *Genentech, Inc. v. Chiron Corp.*,

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112 F.3d 495, 501, 42 USPQ2d 1608, 1613 (Fed. Cir. 1997) ("Comprising" is a term of art used in claim language which means that the named elements are essential, but other elements may be added and still form a construct within the scope of the claim.); *Moleculon Research Corp. v. CBS, Inc.*, 793 F.2d 1261, 229 USPQ 805 (Fed. Cir. 1986); *In re Baxter*, 656 F.2d 679, 686, 210 USPQ 795, 803 (CCPA 1981); *Ex parte Davis*, 80 USPQ 448, 450 (Bd. App. 1948) ("comprising" leaves "the claim open for the inclusion of unspecified ingredients even in major amounts").

Applicant further argues substituting the wear layer of Ehrhart destroys the invention of Shavlol because Ehrhart does not teach stain resistance is possible in pigmented topcoats. In response to applicant's argument that Ehrhart destroys the invention of Shavlol because Ehrhart does not teach stain resistance is possible in pigmented topcoats, the test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference; nor is it that the claimed invention must be expressly suggested in any one or all of the references. Rather, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981). Ehrhart teaches stain resistance in top coats, such as the pigmented top coat of Shavlol. Applicant points to Tomotsugu et al. (U.S. 5,338,613) and Friedlander et al. (U.S. 5,536,760) to teach pigments are known to interfere with radiation cure of resins and colored pigments absorb or block uv light. These references lack relevance because they do not teach that all colored pigmented topcoats absorb or block uv light thereby interfering with UV curing of a composition. Applicant argues

claims 6,8,17,19,25 and 28 require the topcoat layer to be in register with the printed or embossed texture as intended by Applicants as defined on page 1912 of Webster's Third New International Dictionary of the English Language Unabridged. This definition is rendered new matter because it is not supported by the instant specification.

Applicant seeks to introduce new material into the case via Webster's Third New International Dictionary of the English Language Unabridged. Furthermore Shavlol shows the topcoat or wear layer being superimposed with the embossed textures in Figure 2.

9. THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Conclusion

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Lawrence Ferguson whose telephone number is 571-272-1522. The examiner can normally be reached on Monday through Friday 9:00 AM – 5:30PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Cynthia Kelly, can be reached on 571-272-1526. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Lawrence D. Ferguson
Examiner
Art Unit 1774

CYNTHIA H. KELLY
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 1700

